UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,634	03/09/2001	Shimon Shmueli	4989-005	8535

27820	7590	08/26/2004

WITHROW & TERRANOVA, P.L.L.C.
P.O. BOX 1287
CARY, NC 27512

EXAMINER
FADOK, MARK A

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/802,634	SHMUELI ET AL.
	Examiner	Art Unit	
	Mark Fadok	3625	*MK*

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>20 May 2004</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-7,9-19 and 21-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-7,9-19 and 21-27* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/5,3/8 ,7/21/2004*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicants response to office action mailed

3/5/2004, which was received 5/20/2004. Acknowledgement is made to the amendment

to claims 1,13,21 and the cancellation of claims 8,20 and 28, leaving claims 1-7,9-19,

and 21-27 as pending in the application. The amendment was sufficient to overcome

the claim objection, however, the amendments and arguments, which were carefully

considered, were found not persuasive in overcoming the rejection on the merits, which

is modified as required and necessitated by amendment.

Claim Objections

Claim14 and 19 are objected to because of the following informalities: these

claims have references to paragraphs a through c. These paragraph letters were

removed in the independent claim through the amendment. Appropriate correction is

required.

Official Notice Traversal

A "traverse" is a denial of an opposing party's allegations of fact. The

Examiner respectfully submits that applicants' arguments and comments do not

appear to traverse what Examiner regards as knowledge that would have been

generally available to one of ordinary skill in the art at the time the invention

was made (see claims 2,7,14,19,22, and 27). Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an <u>adequate traverse</u> because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An <u>adequate</u> traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. <u>In re Boon</u>, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well known statement (other than those feature amended to claims 1,13 and 21, for which a reference is provided) during examination, then the object of the well known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the

responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the context of the passage as taught by the prior art

or disclosed by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1,3-6,9-13,15-18,21 and 23-26 are rejected under 35 U.S.C. 103(a) as

being unpatentable over O'Leary et al. (US 6,609,113) in view of Rallis et al. (US

6,425,084).

In regards to claim 1, O'Leary discloses a portable device comprising: a) a body

(col 5, lines 55-60, PDA and cell phone technologies, note: applicant's invention PG pub

2002/0147653, page 3, para 31, indicates that the key can be implemented on a PDA or

mobile phone);

b) memory within the body containing software and financial account information (col

4, lines 55-65 and col 5, lines 15-20);

O'Leary teaches interacting with a smart card (col 1, line 36), which is known to

carry personal information that can be transferred to a host device and loading software

to a processor, (see Payment Portal Processor (PPP)). This software program

augments any Internet browser with e-commerce capability. O'Leary, however, does not

specifically mention that the device has an interface that facilitates interaction with the

computing device. Rallis teaches a key that is inserted into a host computer containing

memory. It would have been obvious to a person having ordinary skill in the art to

include in O'Leary the key device of Rallis, because this would allow personal

information and computing software to be transported to accessing devices, creating

improved security and accessibility (see Rallis col 1, protection of data in smart cards

and the needed improvement to protect the device from use).

     d) the software adapted to execute on the host computing device to instruct the host

computing device to:

i)   recognize financial account fields in a web page during a

browsing session (col 5, lines 15-40); and

ii)   fill in the financial account fields in the web page with the

financial account information from the portable device to facilitate a web-based

transaction (col 5, lines 29-35, payment forms automatically filled out).

        <u>automatically execute on the host computing device in association with the</u>

<u>computing session (col 9, lines 9-30); and</u>

        The combination of O'Leary and rallies teach protecting user information

and transferring information from a device to a host, but does not specifically mention

the removal of records pertaining to the computing session from the host computing

device to enhance privacy associated with the computing session. De la Huerga

teaches instructions for overwriting and deletion of any memory cache or temporary

workspace used by the user after log off (FIG 15E). It would have been obvious to one

having ordinary skill in the art at the time of the invention to include in the combination

of O'Leary/Rallis the removal of records pertaining to the computing session from the

host computing device to enhance privacy associated wit the computing session as

taught by de la Huerga, because this would provide increased security from hackers

trying to attain personal information that was cashed on the computing device (de la

Huerga, col 5, lines 10-25).

In regards to claim 3, O'Leary teaches wherein the software is further adapted

to provide an authentication routine to execute on the host computing device (col 5,

lines 50-67),

O'Leary teaches authenticating using indicia (col 17, liners 1-10), but does not

specifically mention that the indicia is from a portable unit. Rallis teaches authenticating

a user by way of a portable key that stores encrypted identifying indicia which is

validated with stored matching information on a second device (see abstract and FIG 1).

It would have been obvious to a person having ordinary skill in the art at the time of the

invention to include in O'Leary storing indicia on a portable device for authentication,

because by having portability, the item could be used as a sophisticated key and

improve the usefulness of the system of O'Leary by not requiring the user to remember

complex algorithms.

In regards to claim 4, O'Leary teaches wherein the portable device stores login information for a web site associated with the web-based transaction (col 9, lines 11-30) and

the software is further adapted to instruct the host computing device to determine if login information is necessary for the web site and provide the login information upon entering the web site (col 14, lines 20-30).

In regards to claim 5, O'Leary teaches wherein a bookmark for the web site is stored on the portable device and

the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that a user may use the bookmark to efficiently access the web site via the browser (col 9, lines 1-30, website button link).

In regards to claim 6, O'Leary teaches wherein the portable device stores shipping information for an item selected for purchase during the web-based transaction and

the software is further adapted to instruct the host computing device to access the shipping information and provide the shipping information to the web site to facilitate delivery of the item selected for purchase (col 9, line 62 through col 10, line 12).

In regards to claim 9, O'Leary teaches wherein the software is adapted to emulate a file system resident on the host computing device when interacting with the host computing device. (col 5, lines 15-40, saved wallet data)

In regards to claim 10, O'Leary teaches wherein the software is adapted to appear as a file system to the host computing device (FIG 6, Item 215, wallet).

In regards to claim 11, O'Leary teaches wherein the interface is adapted to directly interface a port in the host computing device (Rallis, FIG 1A and 1B).

In regards to claim 12, O'Leary teaches wherein the interface is adapted to provide a wireless interface with the host computing device (col 5, lines 55-60, cell phones and PDA's).

In regards to claim 13, O'Leary discloses a computer readable medium including software to reside on a portable device capable of interacting with a plurality of host computing devices,

the software comprising instructions for the host computing device to:

a) execute on the host computing device during a computing session;

b)recognize financial account fields in a web page during a browsing session; and

c) fill in the financial account fields in the web page with

financial account information stored on the portable device to facilitate a web-based

transaction.

said software further adapted to execute <u>automatically execute on the host</u>

<u>computing device in association with the computing session; and</u>

<u>in association with termination of the computing session, instruct the host</u>

<u>computing device to remove records pertaining to the computing session from the host</u>

<u>computing device to enhance privacy associated wit the computing session</u> (see

response to claim 1).

In regards to claim 15, O'Leary teaches wherein the software is further adapted

to provide an authentication routine to execute on the host computing device,

the authentication routine instructing the host computing device to receive

authentication indicia from a user via an interface on the host computing device and

determine if the authentication indicia received from the user matches authentication

indicia stored on the portable device (see response to claim 3).

In regards to claim 16, O'Leary teaches wherein the portable device stores

login information for a web site associated with the web-based transaction and the

software is further adapted to instruct the host computing device to determine if login

information is necessary for the web site and provide the login information upon

entering the web site (see response to claim 4).

In regards to claim 17, O'Leary teaches wherein a bookmark for the web site is stored on the portable device and the software is further adapted to instruct the host computing device to make the bookmark accessible by a browser running on the host computing device such that the user may use the bookmark to efficiently access the web site via the browser (see response to claim 5).

In regards to claim 18, O'Leary teaches wherein the portable device stores shipping information for an item selected for purchase during the web-based transaction and the software is further adapted to instruct the host computing device to access the shipping information and provide the shipping information to the web site to facilitate delivery of the item selected for purchase (see response to claim 6).

In regards to claim 21, O'Leary discloses a method for facilitating a web-based transaction using a portable device capable of interacting with a plurality of host computing devices, the method comprising: a) executing software resident on the portable device on a host computing device in association with a computing session; b) recognizing financial account fields in a web page during a browsing session; and c) filling in the financial account fields in the web page with financial account information stored on the portable device to facilitate a web-based transaction and remove records pertaining to the computing session from the host computing device to enhance privacy

associated with the computing session in association with termination of the computing

session (see response to claim 1).

In regards to claim 23, O'Leary teaches receiving authentication indicia from a

user via an interface on the host computing device and determining if the authentication

indicia received from the user matches authentication indicia stored on the portable

device (see response to claim 3).

In regards to claim 24, O'Leary teaches wherein the portable device stores

login information for a web site associated with the web-based transaction and further

comprising determining if login information is necessary for the web site and providing

the login information upon entering the web site (see response to claim 4).

In regards to claim 25, O'Leary teaches wherein a bookmark for the web site is

stored on the portable device and further comprising making the bookmark accessible

by a browser running on the host computing device such that a user may use the

bookmark to efficiently access the web site via the browser (see response to claim 5).

26. The method of claim 21 wherein the portable device stores shipping information for

an item selected for purchase during the web-based transaction and further comprising

accessing the shipping information and providing the shipping information to the web

site to facilitate delivery of the item selected for purchase (see response to claim 6).

Claims 2,7,14,19,22, and 27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over O'Leary et al. (US 6,609,113) in view of Rallis et al. (US

6,425,084), in view of de la Huerga (5,960,085) and further in view of Official

Notice.

In regards to claim 2, the combination of O'Leary and Rallis teaches multiple

financial accounts and debit card numbers stored on a portable device along with

accessing these items (col 9, line 62 through col 10, line 12), neither, however,

specifically mentions that the program queries the user for the proper entry. The use of

pull down menus to offer such selections and later filling in the selected choice was old

and well known in the art at the time of the invention. It would have been obvious to a

person having ordinary skill in the art to include in O'Leary a presentation of choices

and a selection method such as a pull down menu, because this would offer a

convenient way of presenting the stored information and has been known to speed

selection and save space on a web form.

In regards to claim 7, O'Leary teaches multiple shipping addresses and

alternate shipping addresses stored on a portable device along with accessing these

items (col 9, line 62 through col 10, line 12), but does not specifically mention that the

program queries the user for the proper entry. The use of pull down menus to offer

selections and later filling in the selected choice was old and well known in the art at the

time of the invention. It would have been obvious to a person having ordinary skill in the

art at the time of the invention to include in O'Leary a presentation of choices and

selection method such as a pull down menu, because this would offer a convenient way

of presenting the stored information and has been known to speed selection and save

space on a web form.

In regards to claim 14, O'Leary teaches wherein the financial account

information relates to a plurality of financial accounts, the software further adapted to

instruct the host computing

device to:

a) query a user to select one of the plurality of financial

accounts;

b) receive selection indicia from the user; and

c) fill in the financial account fields in the web page with certain

of the financial account information corresponding to the selected one of the plurality of

financial accounts (see response to claim 2).

In regards to claim 19, O'Leary teaches wherein the shipping information

includes a plurality of shipping addresses,

the software further adapted to instruct the host computing device to:

a)   query a user to select one of the plurality of shipping addresses;

b) receive selection indicia from the user; and

b)   fill in the shipping address fields with certain of the shipping

information corresponding to the selected one of the plurality of shipping addresses

(see response to claim 7).

In regards to claim 22, O'Leary teaches wherein the financial account

information relates to a plurality of financial accounts, the method further comprising: a)

querying the user to select one of the plurality of financial accounts; b) receiving

selection indicia from the user; and c) filling in the financial account fields in the web

page with certain of the financial account information corresponding to the selected one

of the plurality of financial accounts (see response to claim 2).

In regards to claim 27, O'Leary teaches wherein the shipping information

includes a plurality of shipping addresses and further comprising: a) querying a user to

select one of the plurality of shipping addresses; b) receiving selection indicia from the

user; and c) filling in the shipping address fields with certain of the shipping information

corresponding to the selected one of the plurality of shipping addresses (see response

to claim 7).   .

Response to Arguments

In response to applicant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention
where there is some teaching, suggestion, or motivation to do so found either in the
references themselves or in the knowledge generally available to one of ordinary skill in
the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re
Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both patents are
concerned with the security of personal information that is entered into a network of
computing devices.

Applicant argues the citing of Official Notice in regards to the removal of legacy
information found in the amendment to claims 1,13 and 21 and asks that a reference be
provided. The examiner draws upon the teaching of de la Huerga, that teaches
overwriting and deleting any memory cache or temporary workspace used by the user
or application program run by the user (FIG 15E).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in
this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed within
TWO MONTHS of the mailing date of this final action and the advisory action is not
mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-**

4252. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00

PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the **Receptionist** whose telephone number is

(703) 308-1113.

Any response to this action should be mailed to:

<div align="center">

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

</div>

or faxed to:

(703) 872-9306   [Official communications; including

After Final communications labeled

"Box AF"]

(703) 746-7206 [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal

Drive, Arlington, VA, 7th floor receptionist.

Mark Fadok

Patent Examiner

Jeffrey A. Smith

Primary Examiner